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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------------|---------------------|------------------|
| 10/771,380 | 02/05/2004 | Tokio Oi | 118520 | 3333 |
| 25944 7590 06/11/2010 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER HENDRICKSON, STUART L | | | | |
| ART UNIT 1793 | | PAPER NUMBER | | |
| NOTIFICATION DATE 06/11/2010 | | DELIVERY MODE ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com
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Office Action Summary

Application No.

10/771,380

Applicant(s)

OI ET AL.

Examiner

Stuart Hendrickson

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-12, 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 8-12, 14-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is insufficient support for the newly claimed feature of liquid naphthalene. Specification paragraphs 35-41 do not provide sufficient support.

Claims 1, 3, 5, 8, 10, 12, 14, 16, 18 are rejected under 35 U.S.C. 103(a) as obvious over Walker 3638399 taken with Hayden 5466645.

Walker teaches in col. 2 and 4 treating active carbon having a wide pore size distribution with gaseous naphthalene and like compounds until it is saturated. No differences are seen in the carbon or the effect of the treatment. Note also the cooling of ex. 5. Concerning claim 5, it is implied, however to the extent that it is not taught, it is an obvious expedient to avoid burn-off of the carbon. Walker does not explicitly teach cooling in inert gas, however Hayden does in a similar process. Using this cooling is an obvious expedient to avoid burning of the active carbon and thus preserving its pore structure, consistent with the Walker teachings. As to the mixing of claims 8 and 14, in so far as mixing a gas with a solid is possible, Walker does so. Concerning the liquid state, this is an obvious expedient to provide the desired material in a form in which it can coat the carbon.

Claims 1-5, 8-12, 14-18 are rejected under 35 U.S.C. 103(a) as obvious over the Nakano article taken with Hayden.

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Nakano teaches, especially on pgs. 2, 3, contacting (mixing) molecular sieve carbon (ie, active carbon) with naphthalene and like compounds at 200C and heating in inert gas. Concerning claims 4 and 5, they are implied, however to the extent not taught, are an obvious expedient to avoid burning the carbon.

Nakano does not explicitly teach cooling in inert gas, however Hayden does in a similar process. Using this cooling is an obvious expedient to avoid burning of the active carbon and thus preserving its pore structure. Concerning the liquid state, this is an obvious expedient to provide the desired material in a form in which it can coat the carbon.

Applicant's arguments filed 3/31/10 have been fully considered but they are not persuasive.

With regard to the inventorship, at a minimum a new oath is necessary, including a statement of what the error is, how it occurred and if it was made without deceptive intent. As to the step of using a liquid, this is obvious as explained above. As to the pore structure, no difference has been seen in the effect due to the similarity between the claims and references of the reagents and steps used and previous remarks on that subject are incorporated herein.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

/Stuart Hendrickson/
Primary examiner Art Unit 1793